

REMARKS

I. Applicant believes there is a strong possibility that reopening prosecution after losing an appeal without citing new art is improper. There is a strong presumption that all of the art cited by the Examiner was considered and only the best art of the cited art was applied. This presumption is implicit in 37 C.F.R. § 1.104, which states that the Examiner shall make a thorough investigation of the available prior art. The Rule further states that every action shall be complete with respect ... to the patentability of the invention. A stated reason for this action on the part of the Patent Office is so that the applicant can judge the propriety of continuing the prosecution. Even more so, it provides continuity and faith in the system. In the present case, for example, 23 references were cited prior to the reopening of prosecution. Potentially, by the procedure just initiated, Applicant could be looking at 15 or 20 additional appeals. This is unconscionable and clearly not within the Patent Law or Rules.

II. Also, Applicant believe there is a strong possibility that *res judicata* makes reopening prosecution improper, when the rejection is on the same cited prior art

considered prior to winning the appeal. Applicant understands that the Patent Office can reopen prosecution after losing an appeal. This premise was well litigated in *The Jeffry Manufacturing Co. v. Kingsland, Comr. Pats.*, 77 USPQ 500 (Dist. Court D.C. 1948) and 83 USPQ 494 (Appls. Court D. C. 1949). However, in all such cases the reopening was based on the citation of new prior art. The reason for this, of course, is that all of the art cited prior to the appeal was considered by and comes within the decision of the court (or the Board) of appeals. Thus, since the old prior art was considered by the court (or the Board) of appeals, *res judicata* applies to using it to reopen prosecution. Here it must be remembered that the "*res judicata* doctrine imposes finality of decision not only upon issues actually raised but upon issues which might have been raised." *Knutson et al. v. Gallsworthy*, 74 USPQ 327 (Co. of App. D.C. 1947)

III. Further, it is paramount in the U.S. Patent System that there is a presumption of validity on issued patents (35 U.S.C. 282) which arises because it is assumed that the Examiner carefully considered all of the cited art. In any action against a U.S. Patent (e.g. invalidity issues) the "burden of showing invalidity is especially difficult when prior art was before Patent and Trademark Office

examiner during prosecution of application." Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ 2d 1525 (CAFC 1990). The reason for this is the 37 C.F.R. § 1.104 proscription against piecemeal actions. Certainly, the Patent Office must have a difficult burden to show obviousness of an invention when reopening prosecution and reapplying prior art that was before the Examiner, and by extension the Board of Appeals, after losing an appeal. Merely, taking judicial notice of a list of items in the claim does not carry this difficult burden. Clearly, if the invention were so obvious in view of a single patent, the Examiner or the Board of Appeals would have found it during the extensive prosecution.

IV. Regarding the rejection of claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over Walsh. In applying the teachings of Walsh, the Examiner in several instances states "a pouch 10 formed of a plastic material 30, 36 to provide water impermeability" (emphasis added). Walsh never in his entire disclosure mentions anything about moisture or water permeability yet the Examiner's summary makes it sound like an intended feature. Whether Walsh's insulated pizza pie container is water impermeable is not discussed by Walsh and, therefore, not taught by Walsh.

All of the claims considered by the Board of Appeals include the element "the lips formed to provide a passive, non-sealing engagement between the lips". The Examiner states that this is inherent in the Walsh structure because "the resilient nature of the insulating material 34 in the walls 16, 20 inherently cause the lips 24 to provide a 'passive, non-sealing engagement between the lips' as claimed." First, no lips are shown or described by Walsh. The number 24 indicates the front of the wall member 14 (Col. 2, lines 17-18). Further, Walsh only describes an opening in front 24 extending part way into the sides. "To permit sealing of article 40 within insulated container 10, the opening is provided with a suitable closure such as a zipper 42." (Col. 2, lines 44-46, emphasis added.) Thus, the only teaching by Walsh as to the character of the opening is that it seals article 40 within the insulated container. Nothing in the teaching of Walsh even remotely suggests "lips formed to provide a passive, non-sealing engagement between the lips".

The statement by the Board of Appeals on page 9 of their Decision answers this rejection as good or better than the previous rejection:

It is clear to us that the teachings of the applied prior art would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have modified the protective case of Attaway to arrive at the claimed subject matter for the reasons set forth by the appellant in the Brief (pp. 14-23). In that regard, the applied prior art is not suggestive of the claimed non-sealing engagement between the lips which inhibits a build-up of moisture vapor produced from warm food disposed in the warming chamber for preventing warm food disposed in the warming chamber from becoming soggy and allows enough moisture vapor to remain in the warming chamber for keeping warm food disposed in the warming chamber moist as set forth in independent claims 1, 8 and 14.

Thus, it is clear that claims 1-20 are in condition for allowance. Withdrawal of the rejection is respectfully requested.

SUMMARY

Since the rejection after reversal on appeal is believed improper and since the applied reference does not teach or suggest applicant's claimed structure and since the applied reference cannot achieve the functions of the present invention, applicant believes that claims 1-20 are in condition for allowance.

In view of the foregoing, it is submitted that each of the claims is in condition for allowance. Withdrawal of the rejections and allowance of the claims is respectfully requested. Should there be any questions or remaining issues, Examiner is cordially invited to telephone the undersigned attorney for a speedy resolution.

Respectfully requested,



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